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IN THE

Supreme Court of the United States

OCTOBER TERM 1957

No. 640

BRIGGS & STRATTON CORPORATION,
Plaintiff-Petitioner,

vs.

CLINTON MACHINE COMPANY,
Defendant-Respondent

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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STATEMENT OF THE CASE

This is a typical patent case and involves no more than the usual and ordinary application of well established principles of patent law to claims fully met by the prior art. The District Court found petitioner's patent invalid and the Court of Appeals affirmed. The Courts below had

no problem in recognizing lack of invention when the prior art was adequately presented, and there is no conflicting decision of any other court.

Petitioner (appellant below), long dominant in the small engine industry (R. 400), sought through the assertion of three patents originally involved in the case to monopolize old and well-known techniques and practices of the engine art. In the original trial the Court held two of petitioner's patents invalid, but, greatly impressed with the similarities of petitioner's and respondent's lightweight engines and not then being fully apprised of the prior art, erroneously sustained the patent asserted here under the misapprehension (withdrawn Finding 15, R. 201) that Lechtenberg had contrived a new line of separation (now characterized by petitioner as Lechtenberg's "slice") between the cover and the main casting.

The lightweight engines of both petitioner and respondent make common use of the same old expedients and techniques of the prior art and are made and competitively sold for the same use and customer requirements, and often to the same customers. Defendant's cross-appeal on the question of infringement was dismissed as moot by the Court of Appeals, but as respondent's cylinder-crankcase block incorporating a cast iron cylinder liner is not a SINGLE or ONE casting as specified in each of Lechtenberg's claims in issue, respondent asserts that its engines do not infringe.

After the existence in the prior art of the exact structure and arrangement claimed in the patent here involved was brought to its attention at the supplemental trial, the trial court recognized that its original "finding [No. 15, R. 201] as to patentable invention was erroneous" (R. 459); found "that the adaptability of engines to various

and different uses by means of interchangeable bottom parts was not new," (R. 459), and held that the patent asserted here was "an aggregation of old elements which, in the aggregation, perform and produce no new or different function or operation than that heretofore performed or produced by them" (R. 460).

In affirming, the Court of Appeals pointed out that appellant's extended argument does not "proceed upon any reference to or quotations from the claims of the patent" and that "the claims of the patent broadly cover two cycle single cylinder engines and both sand and die cast cylinder and crankcase elements and * * * contain no such limitation or definition of invention as appellant contends for" (Petition, A-6). Further, the Court of Appeals (relying on *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271) specifically held that the Lechtenberg patent "cannot be saved by asserting limits to the claims not contained in them" (Petition, A-7), as petitioner in effect seeks to do in this Court.

Petitioner, admitting that the claims define old structural elements performing old functions, erroneously asserts that Lechtenberg "defines a new arrangement of those structural elements", or a "structural change" (Petition, pp. 2, 3, 4, 8, 9, 10 and elsewhere), relying heavily on the concurring opinion of Judge Sanborn in the Court of Appeals. The trial court's original and now admittedly erroneous Finding No. 15 was based upon the mistaken belief that Lechtenberg's separation of the cover from the main casting was not disclosed in the prior art, whereas such arrangement and separation are clearly shown in the prior art relied upon at the supplemental hearing, namely, the Bosma (R. P. 335), Conover (R. P. 305), and Vansickle (R. P. 1) patents and the prior art Lauson engine (R. 244-250, 357-358, Ex. D-78, Ex. D-83)—prior art not considered by the Patent Office.

While the petition repeatedly uses the term "slice" to define Lechtenberg's invention, such term does not appear in the Lechtenberg patent and was first used in this case in petitioner's PETITION FOR REHEARING before the Court of Appeals. The "slicing" petitioner now asserts to be novel with Lechtenberg, and designated heretofore as the "structural relationship", "separation", or the "parting line", is the same as that of Conover, Bosma, Vansickle, and the prior art Lauson engine.* The trial court's reversal of its original finding of invention in the separation of the engine body demonstrates that the asserted "new arrangement" or "structural change", now deceptively presented in the guise of Lechtenberg's "slice", is *not* new and involves *no* change over the prior art. Petitioner, in asserting that "Nobody in the industry had ever before thought of putting the 'slice' in the place where Lechtenberg said it should be" (Petition, p. 9) wholly ignores the above-mentioned prior art.

Petitioner's assertion that its patent relates to four-cycle engines is only a half-truth because, as held by the Court of Appeals, "Some of the claims of the patent broadly cover two cycle single cylinder engines" (Petition, A-6). See patent claim 1 (R. P. 532).

Petitioner's assertion that Lechtenberg's "slice" made die casting *economically* feasible, tacitly confesses the feasibility of die casting the prior art engines and is misleading because die cast two-cycle engines and four-cycle engine parts are admittedly old (R. 255, 269, 321, 369-370). The record shows that the die casting techniques are the same for both two and four cycle engines (R. 293) and that die casting of either presented no problem (R. 281, 282).

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*Claims *not* in issue, such as Claim 10, refer to a "plane of parting" between the main and cover castings, but no such plane is specified in the claims in issue here.

In emphasizing "producibility" here, as it did in the Court of Appeals (where it was labeled "die-castability"), petitioner not only conveniently overlooks the fact that the Lauson engine could have been die cast (R. 252, 281, 417) and that the Conover patent discloses, Figs. 17 and 18, a die cast single cylinder engine, but wholly ignores the trial court's express Findings, holding Lechtenberg invalid, that:

> "The casting of the cylinder and crankcase as an integral unit was not new.
>
> "The die casting of engine parts was not new.
>
> "The use of aluminum was not new.
>
> "Having one wall of the engine removable was not new.
>
> "Having the bottom cover of the engine removable was not new.
>
> "* * * the adaptability of engines to various and different uses by means of interchangeable bottom parts was not new." (Findings 15 and 16, R. 458, 459.)

The Lechtenberg patent (col. 1, lines 43-44, 55-56, R. P. 527) specifically defines casting to include both sand casting and die casting. The *claims* make no mention of die casting and are drawn broadly to a cylinder and crankcase which is a *single* or *one* casting, regardless of the casting method practiced to obtain such casting. The claims in issue do not require that the cover be a casting, or be formed of only one piece, although some of the claims *not* in issue specify that the cover is a casting. (See claim 10.) Petitioner's attempt to salvage the claims by interpretative limitation to "economically feasible die casting," a practice condemned by this Court in *Graver Tank & Mfg.*

Co. v. Linde Air Products Co., supra, was flatly rejected by the Court of Appeals for the reason that the Lechtenberg patent "has no claims that would justify a patent for invention in the method of production of its elements" (Petition A-7).

Petitioner's Figures 1, 2 and 4 (opposite pages 6, 7 and 10, respectively, of the Petition) are not part of the record below, although they appeared in petitioner's main brief before the Court of Appeals. While Figure 4 may correctly reflect prob'ems peculiar to the adaptability of *petitioner's* prior engines, it does not fairly or accurately reflect the expedients of adaptability and interchangeability known and used in the art by respondent and others prior to Lechtenberg and found by the courts below to be in the prior art (R. 459-460). While petitioner's Figure 3 may illustrate *some* prior art four cycle engine bodies, it does not illustrate the Lauson, Conover or Vansickle engines, which have the same "slice" as Lechtenberg's.

Petitioner's characterization of the prior art is incomplete and misleading as to the state of the prior art upon which the courts below relied in holding the claims invalid. The fact is that all of the claims read squarely upon the prior art, and despite petitioner's repeated assertions to the contrary, there is no novelty in Lechtenberg's claimed structure nor any new result achieved thereby.

Petitioner incorrectly asserts (p. 9) that it is Lechtenberg's "slice" which "permits an engine manufacturer with only one cylinder-crankcase mold to turn out a full line of four-cycle engines of one size". Clinton has been using this practice in its 700 Series engines since at least 1949 (R. 258-267, 295, 321). Conover discloses this concept (R. 349-350, R. P. 310, Col. 1, lines 48-52), and this expedient was also used by Lauson in its prior art engines

using the same main casting but different covers for engines made for use on power mowers and as outboards (R. 246-250, 257-258). The producibility technique claimed for Lechtenberg is nothing but the old expedient of interchangeability of engine parts, a practice notoriously common in the engine industry where it has long been used to obtain model variations without a full set of tooling for each different model produced. The District Court specifically held that "It now appears *beyond a reasonable doubt* that prior to Lechtenberg * * * there was wide prior use of interchangeable parts to adapt an engine to various and different uses" (Findings No. 16, R. 460, emphasis added.)

ARGUMENT

I. Lacking Novelty, the Lechtenberg Patent Raises No Issue under 35 USC 101, Which Requires that a Patentable Invention or Improvement Be NEW.

Petitioner's entire argument is based upon the completely erroneous premise that Lechtenberg claims an engine which is structurally changed from those in the prior art. In its effort to advance some ground on which this Court would be warranted in reviewing this case, the Petition erroneously asserts that there are in this case "express findings that the claims distinguish from the prior art" (p. 12), that: "The courts below expressly found that Lechtenberg's structural arrangement is novel" (p. 18), and that: "all of the Lechtenberg claims are directed to a structural change which the courts below have expressly found to be novel" (p. 15). Petitioner has not pointed out where such findings appear and, in fact, neither the District Court's Opinion nor Judge Woodrough's

Opinion for the Court of Appeals contain any such findings.

Petitioner repeatedly asserts that Lechtenberg's "invention" made it possible to die cast a four-cycle engine body for the first time. Such assertion is merely an unsupported conclusion and wholly ignores the fact that the *claimed* structure by which such result is allegedly brought about by Lechtenberg is identical to that disclosed in the prior art. The claims read directly upon the prior art and thus it is not Lechtenberg's theoretical "slice" that made die casting of an engine possible, because such prior art engines, having the same "slice," could have been die cast (R. 252, 282, 417) with a comparable reduction in weight and cost. Other than the gratuitous assertion that Lechtenberg's "slice" is new, petitioner significantly makes no effort to point out how any claim avoids the prior art and relies for this vital part of its case on erroneous assertions as to what the courts below have held. As stated by the Court of Appeals, petitioner's argument "does not include or proceed upon any reference to or quotations from the claims of the patent" (Petition A-6).

Once it is realized that Lechtenberg has in fact no structural change and claims nothing that is novel, then it is clear that there is no issue under 35 USC 101 that needs to be resolved by this Court. Lechtenberg's claims are for an internal combustion engine and that is clearly the type of subject matter for which a patent may be had, *providing* the requirements of novelty and invention are met. The decisions below correctly held that such requirements have not been met.

Neither the District Court nor the Court of Appeals have held, either expressly or by implication, that the kind of "invention" that Lechtenberg made is not the kind that

falls within the statutory classes set forth in 35 USC 101, and petitioner raises a false issue in so asserting.

II. The Lechtenberg Patent Claims, Which Define Nothing More Than a Combination of Old Elements Arranged in an Old Way, Were Properly Held Invalid on the Ground of Aggregation.

Petitioner's argument that Lechtenberg's claims are not subject to the defense of "aggregation" because he was trying to improve the producibility of an engine—again supported with erroneous assertions that Lechtenberg provided a new arrangement which the Courts below expressly found to be novel—ignores the fact that all of the elements claimed are old and perform the same functions they have always performed, without any new result.

Despite petitioner's argument concerning producibility of an engine body, the fact is that the claims of the Lechtenberg patent are not directed to a method of producing the same. The "slice" by means of which the main casting is separated from the cover is not in fact a new "slice" and is exactly the same as that disclosed in the prior patents to Vansickle, Bosma and Conover and utilized in the prior use Lauson engine. The advantages of the "slice" now attributed to Lechtenberg—the use of interchangeable covers to adapt the engine to different uses—were present in the Lauson prior use engine which had interchangeable covers to adapt it for lawn mower or outboard motor use (R. 246-250). The same concept is disclosed in the Conover patent (R. 349-350).

In attempting to save its Lechtenberg patent petitioner is in effect asserting that it alone is entitled to produce an old and unpatentable prior art structure by an old and well-known production method (die casting), and this de-

spite the fact that the claims under which the monopoly is asserted read directly on the prior art and say nothing about die casting, and the specification clearly treats die casting and sand casting as equivalents. Petitioner's suit against Lauson (Petition, p. 22) well demonstrates petitioner's attempt to monopolize the old techniques and practices of the prior art, as the engine there accused is the die cast counterpart (R. 253-254) of the Lauson prior use engine upon which the courts below relied in invalidating Lechtenberg.

"Producibility," the adaptability found by the trial court to be old, adds nothing to the Lechtenberg patent because the claims merely define an old structure arranged in an old way and producing no new result. Lechtenberg's claims are clearly invalid under the well-recognized test of invention appropriate to claims which define a combination of old elements. *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147; *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545; and *Hotchkiss v. Greenwood*, 11 How. 248. To hold otherwise would in effect sanction the repatenting of the prior art.

III. This Case Presents No Occasion for This Court to Pass upon the Standard of Invention Embodied in 35 USC 103.

Whether 35 USC 103 sets forth any different standard of invention than that embodied in the decisional law of this Court is a question that does not arise in this case. The test of "obviousness" laid down in Section 103 contains a condition precedent that the invention in question be not identically disclosed or described in the prior art. In the present case the structure defined in Lechtenberg's claims is identical to structures in the prior art, and thus

whether Lechtenberg's claimed structure would have been obvious is a question that does not arise since the claims are invalid as a matter of law.

The Conover patent discloses a single cylinder die cast aluminum engine in which the only removable wall is that wall through which the power takeoff end of the crankshaft passes, exactly as claimed by Lechtenberg. To use that same construction in a four-cycle engine is too obvious to require extended discussion.

Since the prior art discloses engine bodies in which the "slice", or separation, is made at the wall through which the power takeoff end of the crankshaft passes, and since the Lauson engine and the Conover patent specifically disclose the use of interchangeable covers for such wall of the crankcase to adapt the engine for various uses, the use and advantages of such a construction are a part of the public domain and cannot be monopolized by petitioner. While petitioner asserts that Lechtenberg achieved a universally adaptable engine body, the fact is that respondent's prior art sand cast 700 Series Engine had a universally adaptable engine body with a series of interchangeable covers and adapters to adapt it to all of its customer requirements for a full series of engines of a given size, including both horizontal and vertical shaft engines (R. 295, 321, 433).

As a matter of law, the expedient of interchangeability of parts is unpatentable. See *Elliott Machine Co. v. Rothchild & Co. et al.* (C. A. 7, 1916), 235 F. 896, 897, 898, a case directly in point. Also directly in point is *Ex parte Ludwig, et al.* (Patent Office Board of Appeals, 1951), 95 USPQ 296, 298, 299, where the Patent Office refused a patent on a convertible motor having certain basic parts (as the cylinder crankcase here) common to all different

types of motors, and to which were added different interchangeable parts (as the covers here), to provide a line of motors.

It is significant that despite petitioner's assertions concerning the failure of others to achieve what Lechtenberg allegedly achieved, there is no evidence in the record of any prior unsuccessful effort of others to die cast a four-cycle engine body. When power lawn mowers became so popular that the prospective market warranted the large expenditure for dies, the industry logically took advantage of the obvious savings offered by die casting techniques. As stated by the witness Lechtenberg: "Die casting is a matter of economics" (R. 370). Since Lechtenberg's claims define nothing that is new or different from the prior art, the courts below could not logically have held Lechtenberg's claimed invention to pass the test of "obviousness" set forth in 35 USC 103.

IV. This Case Presents No Issue That Requires Review by This Court.

The Lechtenberg patent is a combination patent in a crowded art and the structure defined in the claims of the patent is fully disclosed in the prior art.

The Courts below have not incorrectly interpreted 35 USC 101 as urged by petitioner. The decisions below correctly recognized the Lechtenberg patent for what it was—a patent in which the claims define a structure that is old and unpatentable in view of the prior art.

The Courts below carefully scrutinized Lechtenberg's claims in accordance with the recognized test of invention stated in the *A & P* case, *supra*, and other decisions involving claims for a combination of old elements arranged in an old way and performing no new function and achieving

no new result. Petitioner asserts that Lechtenberg's structure makes possible a substantial reduction in weight and cost of an engine, but it is clear that petitioner is referring to its commercial practices rather than the structure defined in the claims of the Lechtenberg patent. Quite aside from the fact that the claims will read on a sand cast iron engine as well as a die cast aluminum engine, the fact is that the reduction in cost is obtained only if sufficient quantities of the engine are commercially produced, and certainly patent claims cannot be sustained on the theory that the patent owner elects to produce his claimed device by an old and well-known production method which has always resulted in cost reduction providing the demand warrants high production.

Petitioner relies heavily on the commercial success of its lightweight engine, but the record fails to show that the commercial success can be attributed to the structure defined in the claims of the patent. As stated in the *A & P* case, *supra*, "commercial success without invention will not make patentability."

Die casting techniques have for many years been available and used for the production of engine bodies and many other parts. That Briggs & Stratton, the largest and dominant figure in the small engine field, may have been the first to commercially produce a die cast four-cycle engine in production quantities means only that they were willing for competitive reasons to make the necessary expenditures for dies. Merely being the first to make a four-cycle engine by using a well-known process (when the economic factors in the industry are favorable) used in making two-cycle engines and in numerous other and related arts, does not give petitioner the right to a monopoly to prevent others from using what had formerly been freely available to them. *Jungersen v. Ostby & Barton Co.*, 335 U. S. 560.

While the claims contain no reference to die casting, nothing could be more obvious than to die cast a part rather than to sand cast it if the expected sales volume will warrant the expenditure for the die casting dies.

Articles such as "THE BOOMING MARKET FOR POWER LAWN MOWERS" (Ex. D-108, R. 297-301) and "CUT IN ON THE POWER MOWER BOOM" (Ex. D-109, R. 303-311), both published in 1951, several years prior to introduction of Lechtenberg's engine, show that the asserted commercial success of the lightweight engine was due to a previously developed tremendous demand for engines rather than to any cost reduction that well-known die casting techniques bring about. See also the ten-year sales record on power lawn mowers given in Ex. D-110 (R. 319).

There is no issue arising under 35 USC 103 in this case since the Lechtenberg claims read directly upon the prior art. In the absence of novelty in the claimed structure, it necessarily follows that the claimed structure is obvious within the meaning of 35 USC 103. In any event, whether tested by 35 USC 103 or any other standard of invention, the Lechtenberg patent claims nothing that is new. The courts below have made the definitive pronouncement concerning validity of the Lechtenberg patent that petitioner seeks in this Court.

CONCLUSION

Petitioner has not shown that the decisions below have incorrectly interpreted any section of the patent statutes, nor has petitioner shown that this case presents any unresolved question of patent law that should be reviewed by this Court. It is therefore submitted that the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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